



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/736,532      | 12/11/2000  | Daniel J. Shoff      | MS1-089USC2         | 8374             |

22801 7590 04/07/2006

LEE & HAYES PLLC  
421 W RIVERSIDE AVENUE SUITE 500  
SPOKANE, WA 99201

EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/736,532 | <b>Applicant(s)</b><br>SHOFF ET AL. |  |
|                              | <b>Examiner</b><br>Jason P. Salce    | <b>Art Unit</b><br>2623             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60 and 61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the appeal brief filed on 4/22/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection in regards to the claims is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

In view of the Applicant's arguments presented in the Appeal Brief filed 1/12/2006, the examiner has noted that the use of the Throckmorton reference is redundant for teaching the same concepts that the Dougherty reference already teaches. Therefore the examiner will reject claims 60-61 only using the Dougherty reference under U.S.C. 102(e) (see rejection below).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2623

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 60-61 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dougherty et al. (U.S. Patent No. 5,848,352).

Referring to claim 60, Dougherty discloses a method for enhancing a continuous video content program with supplemental hyperlink content (see Column 3, Lines 8-27 for enhancing a video content program with supplemental data) to provide viewer interactivity with the video content program (see Figure 1 for providing interactivity with a video content program using the supplemental hyperlink content).

Dougherty also discloses configuring digital data, which defines a display layout prescribing how the supplemental hyperlink content and the video content are to appear in relation to one another when displayed (see Figures 7A and 7B and Column 14, Lines 15-37 for the Object Definitions describing how the content is displayed in relation to the video and Column 7, Lines 5-10 for the creation of such data).

Dougherty also discloses transmitting the digital data along with the video content program as two separate signals (see Column 7, Lines 23-33 for transmitting the compact protocol signal (digital data) along with the broadcast program (video content program) as **two separate signals**, the digital data being transmitted in the VBI and the video content program being transmitted in separate location of the television frequency, therefore, two separate signals (the digital data and the video content program) are transmitted separately) from two separate sources (see Figure 2A for the signal provider 208 being the source of the video content program and the compact

Art Unit: 2623

protocol generator 210 being the source of the digital data, therefore providing two separate sources).

Dougherty also discloses displaying the supplemental hyperlink content and the video content program according to the display layout (see Figure 1 and Column 9, Line 65 through Column 10, Line 22 for displaying the digital data along with the video content program in accordance with the layout data).

Referring to claim 61, Dougherty also discloses transmitting the digital data as a first signal from a first source (see the rejection of claim 60 and further note (at Column 7, Lines 23-33) that the digital data is transmitted as a first signal (the digital data itself) from a first source (the compact protocol generator 210 in Figure 2A)).

Dougherty also discloses transmitting the video content program as a second signal from a second source that is different than the first source (see the rejection of claim 60 and further note that the video content program is transmitted as a second signal (the video broadcast program itself) from a second source (the signal provider 208 in Figure 2A)).

The examiner further notes in regards to Applicant's arguments in the Appeal Brief filed 1/12/2006, that Dougherty even further teaches various transmission methods for sending the digital data and video content program to the viewer over separate transmission paths, however, because of the broadest reasonable interpretation taken by the examiner, in view of the claim limitations above, that the applied rejection using the Dougherty reference is proper. However, if the Applicant were to further amend the claims to define two separate transmission paths, as discussed in the Appeal Brief

using the illustration of Figure 4 in Applicant's specification, that Column 8, Lines 11-38 could be applied to teach such an environment.

**Conclusion**


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason P Salce  
Patent Examiner  
Art Unit 2623

March 31, 2006

  
JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

